

3761

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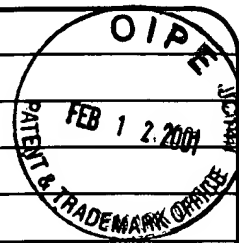
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/551,408	
	Filing Date	April 18, 2000	
	First Named Inventor	Yehuda Ivri	
	Group Art Unit	3761	
	Examiner Name	G. Dawson	
Total Number of Pages in This Submission		Attorney Docket Number	016770-002721US



ENCLOSURES (check all that apply)		
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On Feb 7, 2001

TOWNSEND and TOWNSEND and CREW LLP

By: Connie Suran



#3/c. Re. considered in
new
872
2-21-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yehuda Ivri et al.

Application No.: 09/551,408

Filed: April 18, 2000

For: METHODS AND APPARATUS
FOR STORING CHEMICAL
COMPOUNDS IN A PORTABLE
INHALER

Examiner: G. Dawson

Art Unit: 3761

RESPONSE

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed November 8, 2000. In the Office Action, claims 32-39 (all of the claims pending in the present application) have been rejected as obvious over Ivri et al in view of Dowell et al. This rejection is respectfully traversed for the following reasons.

As noted in the office action, Ivri teaches a device for depositing a liquid solution onto a vibrating plate with tapered apertures for forming droplets of a particular size for inhalation, but Ivri does not disclose the material(s) from which the plate is constructed. Dowell teaches a chemical ionization chamber of a mass spectrometer formed from molybdenum to reduce adsorption, degradation and decomposition of an analyte and to reduce adverse ion/surface reactions. As stated in Dowell, column 2, lines 35-50, chemical ionization

sources have unique requirements for the inner surfaces of the ionization chamber because cleanliness and reactions occurring at those surfaces affect the analytical performance of the spectrometer. As the result of these special requirements, the inner surfaces of the ionization chamber have been coated with materials known for corrosion resistance or inertness, such as gold, nickel and rhodium, to address degradation problems of analytes such as pesticides, drugs and metabolites in the ionization chamber (see, for example, the discussion at column 2, lines 51-67). In contrast to Dowell, Ivri et al and the present invention are not directed to chemical ionization chamber interiors and therefore the teachings of Dowell related to materials from which these devices are constructed are not applicable to applicants' invention. Clearly, the solutions to problems regarding degradation of drugs undergoing chemical ionization for spectrometric analysis involve completely different considerations than problems associated with the degradation of drugs undergoing aerosolization in an apparatus using a vibrating plate with tapered apertures. Although, arguendo, gold/gold alloys may be known to provide enhanced corrosion and drug degradation resistance, for example, in chemical ionization chambers, there is no teaching or suggestion whatsoever in the prior art of the claimed palladium/ palladium alloy vibrating aperture plates in an aerosolizing apparatus. analogous

In light of the above discussion, it is respectfully submitted that the Examiner has not met his burden of establishing a prima facie case of obviousness based on a combination of Ivri and Dowell. It is well recognized that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. There is no such teaching, suggestion or incentive in the cited references themselves and therefore the combination of the Ivri and Dowell references is improper.

In particular, Ivri and Dowell are nonanalogous prior art. As explained above, Ivri is directed to aerosolizing apparatus; Dowell is directed to chemical ionization apparatus. As stated by the Federal Circuit in In re Oetiker, 977 F 2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992):

"The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion,

or motivation found in the prior art, whereby a person of ordinary skill in the field of the invention, would make the combination. That knowledge can not come from the applicant's invention itself."

The Examiner has merely taken applicants' own disclosure on page 12 of the specification that gold/gold alloys and palladium/ palladium alloys can be used in the apparatus of the present invention and combined that knowledge with Dowell's teaching of the use of gold/gold alloys in a non-analogous art to establish that use of palladium/palladium alloys in the Ivri apparatus would have been obvious. This is clearly impermissible under the law.

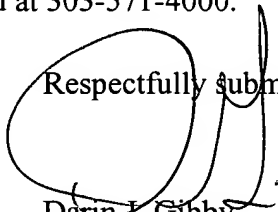
In light of the above, it is respectfully requested that the obviousness rejection of claims 32-39 in view of Ivri and Dowell be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Darin J. Gibby
Reg. No. 38,464

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